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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/611,144	07/06/2000	Wolfgang Neuberger	BJA170A	5264

7590 01/31/2002
Bolesh J Skutnik PhD JD
515 Shaker Road
East Longmeadow, MA 01028

EXAMINER

FARAH, AHMED M

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 01/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/611,144

Applicant(s)
Neuberger et al.

Examiner
A. Farah

Art Unit
3739



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 20) ☐ Other:

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DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because the terms "the present invention" and "this invention" in lines 1 and 23, respectively, are illegal phraseology. Correction is required.

See MPEP § 608.01(b).

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Objections

3. Claim 8 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 7.

When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP

§ 706.03(k).

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Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 4 recites the limitation "said diode lasers" in line 1. There is insufficient antecedent basis for this limitation in the claim.

6. Claim 10 recites the limitation "said homogenized means" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Mersch U. S. Pat. No. 5,468,238.

Mersch discloses an endoscopic laser instrument comprising: distal end and a proximal end; radiation source (13) positioned at the distal end (12); and power supply (17), which

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remotely powers the radiation source 13 via electric cable 15. In reference to claim 6, he provides a cooling means (Col. 3, lines 1-5).

9. Claims 1-4 and 7-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Chen et al. U. S. Pat. No. 5,800,478.

Chen discloses method and a flexible probe adapted for insertion into a patient's body through incision or natural body opening to provide photodynamic therapy (PDT) at a site within the patient's body. His device has a distal and proximal ends and includes a radiation source positioned at the distal end. **Fig. 52** of Chen clearly shows power supply (450), which remotely powers the radiation source (Col. 19, lines 26-29).

In reference to claims 2 and 3, he provides plurality of radiation sources (104) disposed at the distal end of the treatment device. He further teaches that these radiation sources include laser diodes (Col. 8, line 57).

In reference to claim 4, he discloses that the radiation sources operate at different wavelengths and a practitioner selects the wavelengths that are more effective in the photodynamic therapy of an abnormal tissue (Col. 17, line 62 through Col. 18, line 14).

In reference to claim 7, he teaches two different photoactive agents that absorb light at the characteristic wavelength of the light source are applied to the treatment site (Col. 18, lines 5-10).

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In reference to claim 9, Fig. 14 of Chen clearly shows balloon (170), which extends annularly around the outer periphery of the treatment device (Col. 11, lines 32-36). This balloon would serve as a centering mechanism.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. in view of Berry U.S. Pat. No. 6,254,549 B1.

Although Chen, described above, teaches various types of radiation sources (i.e., LEDs, laser diodes, electroluminescent panels, etc.), he does not teach the use of chemiluminescent material for providing the treatment radiation.

Berry discloses an alternative treatment device containing a chemical mixture that produces energy at a desired wavelength capable of causing a desired modification to a humans tissue (see claim 1 and the abstract). Thus, it would have been obvious to one skilled in the art at the time of the applicant's invention to modify Chen's system with Berry and use chemiluminescence material as an equivalent alternative light source in order to generate the treatment light.

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Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the following references:

- | | |
|--------------------|-----------------------------|
| 1. Chen et al. | U. S. Pat. No. 5,782,896 |
| 2. Nordquis et al. | U. S. Pat. No. 6,290,712 B1 |
| 3. Gardetto et al. | U. S. Pat. No. 5,370,649 |

Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Farah whose telephone number is (703) 305-5787. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Linda Dvorak, can be reached on (703) 308-0994. The fax number for the Examiner is (703)746-3368.



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